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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/961,052      | 09/24/2001  | Hirokazu Tanaka      | K-1827CON           | 6719             |

7590 07/01/2003  
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|               |
|---------------|
| EXAMINER      |
| CHOI, FRANK I |

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 1616     | 2            |

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/961,052

Applicant(s)

TANAKA ET AL.

Examiner

Frank I Choi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/319,176.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

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## DETAILED ACTION

### *Specification*

The Specification and claims 2,3,10,11 refer to JIS Z 8730. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claims 2,3,10,11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 3,10,11 refer to JIS Z 8730 which renders the claims ambiguous as industrial standards are subject to change, as such, one of ordinary skill in the art would be in doubt as to which version of JIS Z 8730 should be used to arrive at the appropriate color difference.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 48-29528.

JP 48-29528 expressly discloses the preparation of pigments coated with silicic acid falling within the scope of applicant's claims (Column 3, Example 1, Column 3, 4, Example 3.

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses methods of manufacturing which using pigments and silicic acid as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978). See also *Ex parte Novitski*, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993). Because the prior art process uses a silicic acid coating, said pigments prepared by the prior art process will have a refractive index of at most 1.8 and exhibit a Hunter's color difference in the range of 55 to 84%.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 60-228406.

JP 60-228406 expressly discloses the preparation of pigments coated with silicic acid which used in cosmetics falling within the scope of applicant's claims (See entire reference, especially pages 3-6).

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Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses methods of manufacturing which using pigments and silicic acid as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978). See also *Ex parte Novitski*, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993). Because the prior art process uses a silicic acid coating, said pigments prepared by the prior art process will have a refractive index of at most 1.8 and exhibit a Hunter's color difference in the range of 55 to 84%.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (US Pat. 5,607,504) in view of Nishihara et al. (US Pat. 5,017,231).

Schmid et al. teaches a method of preparing pigments by dispersing in organic silicon and/or aluminum compounds, such as, aluminum triisopropoxide and tetraethoxysilane, in which the organic radicals are hydrolyzed, with the resulting coating having a refractive index of 1.8 or less (Column 5, lines 1-62). It is taught that the pigments can be used in cosmetic preparations (Column 7, line 46).

Nishihara et al. teaches a method of preparing pigments by dispersing in organic silicon and/or aluminum compounds, such as aluminum triisopropoxide and silicon tetramethoxide, in which the metal alkoxide is hydrolyzed wherein the hydrated oxide of the corresponding metal is deposited onto the pigment, which pigments exhibit improved heat resistance, weatherability, light fastness and chemical stability, wherein color difference is by the method of JIS Z8730 (Columns 1-4).

The difference between the prior art is that the prior art does not expressly disclose methods of preparation of pigments and cosmetics by adding a hydrolytic organic silicon

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compound or organic aluminum compound to a dispersion of pigment particles, where the resultant surface as a refractive index of at most 1.8, where the pigment particles have a decrease rate of color difference defined by Hunter's color difference formula define in 6.3.2 of JIS Z 8730 in the range of 55 to 84%. However, the prior art amply suggests the same as methods of preparing pigments having coatings with refractive index of 1.8 or less and in which color differences are measured according to JIS Z 8730, which coatings are prepared from hydrolytic organic silicon and aluminum compounds are known in the art. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that the resultant pigment would be physically and chemically stable.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

### Conclusion

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. ~~Jose Does~~ <sup>Thurmon Page</sup>, can be reached on (703) 308-~~4028~~ <sup>2987</sup>. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

June 27, 2003

JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600